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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,432	03/31/2004	Peter Feldmann	YOR920040053US1	7656
29683	7590	10/31/2007		
HARRINGTON & SMITH, PC 4 RESEARCH DRIVE SHELTON, CT 06484-6212			EXAMINER SHARON, AYAL I	
			ART UNIT 2123	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

5

Office Action Summary	Application No. 10/815,432	Applicant(s) FELDMANN ET AL.	
	Examiner Ayal I. Sharon	Art Unit 2123	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. Claims 1-24 of U.S. Application 10/815,432 filed on 3/31/2004 are currently pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/6/2007 has been entered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 9-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**
5. One may not patent every "substantial practical application" of an idea, law of nature or natural phenomena because such a patent "in practical effect be a

patent on the [idea, law of nature or natural phenomena] itself." Gottschalk v. Benson, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972).

6. While independent claim 1 has been amended to recite that "at least one property comprises one of a fluid mechanical property, an acoustical property or a field scattering property of a radar-related component", the other independent claims have not been amended to include this limitation. The other independent claims 9 and 17 still recite the overly broad limitation of "information indicative of at least one property of a physical entity", which covers every "substantial practical application" of the claimed math.

Allowed Claims

7. Claims 1-8 are allowable.
8. Examiner is persuaded by Applicants' arguments regarding the Ushiro reference as applied in the rejections of independent claims 1, 9, and 17. (See pp.12-15 of the RCE filed on 8/6/07). All rejections based on the Ushiro reference have been withdrawn.
9. Examiner is persuaded that Applicants' amendment to claim 1 to recite that "at least one property comprises one of a fluid mechanical property, an acoustical property or a field scattering property of a radar-related component" overcomes the 35 USC § 101 issue of claiming every "substantial practical application" of an idea.

10. Examiner has also interpreted the “computing” steps in the claims in light of the specification, which recites that the method is implemented in computer aided design (CAD) systems, often involves “tens of millions of elements”, and necessitates “computational efficiency.” (see pp.1-2 of the specification).

Examiner therefore finds that this method claim, which recites an algorithm, must be implemented in a computer. Claims 1-7 therefore differ from the claims in *In re Comiskey*, No.2006-1286 (Fed. Cir. 2007) which were held to be invalid because they did not necessarily require the use of any technology.

Allowable Subject Matter

11. The following is a statement of reasons for the indication of allowable subject matter.

12. Examiner notes that the intended use of “electromagnetic analysis of printed circuit boards” is recited in p.7 of the specification, but is not claimed.

Response to Arguments

Re: Claim Rejections - 35 USC § 101

13. The 35 USC § 101 rejections have been changed in light of Applicants’ amendments.

Art Unit: 2123

Re: Claim Rejections - 35 USC § 102

14. Examiner is persuaded by Applicants' arguments regarding the Ushiro reference as applied in the rejections of independent claims 1, 9, and 17. (See pp.12-15 of the RCE filed on 8/6/07). All rejections based on the Ushiro reference have been withdrawn.

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ayal I. Sharon whose telephone number is (571) 272-3714. The examiner can normally be reached on Monday through Thursday, and the first Friday of a bi-week, 8:30 am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Rodriguez can be reached at (571) 272-3753.

Any response to this office action should be faxed to (571) 273-8300, or mailed to:

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P.O. Box 1450
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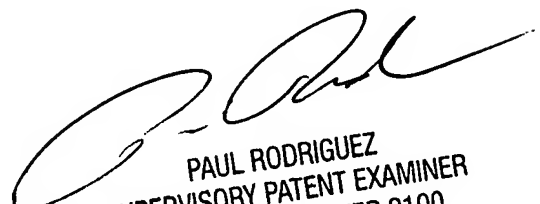
or hand carried to:

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Randolph Building
401 Dulany Street
Alexandria, VA 22314

Art Unit: 2123

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center 2100 Receptionist, whose telephone number is (571) 272-2100.

Ayal I. Sharon
Art Unit 2123
October 27, 2007



PAUL RODRIGUEZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100